

U.S. Patent Appln. Serial No.: 09/830,560
Atty. Docket No.: 206253US-3 PCT
Reply to Office Action of April 17, 2003

REMARKS

Favorable consideration of this application, in light of the present amendment and the following discussion, is respectfully requested.

Claims 39-93 remain pending in this application, claims 44-47 and 52-93 having been withdrawn from consideration by the examiner as being drawn to a non-elected invention or species, and claims 39-43 and 48-51 having been amended by the present amendment.

In the outstanding Office Action, claims 39, 42, 48, and 49 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, claims 39-42 and 48-51 are rejected under 35 U.S.C. § 102(a) as being anticipated by *International Patent Cooperation Treaty Application Publication No. WO 98/57611* (hereinafter "*WO '611*"), and claim 43 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *WO '611* in view of *Imazaike et al.*

In Paragraph No. 2 on page 2, the Office Action states, as follows:

Claims 44-47 and 52-93 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b) as being drawn to a nonelected invention and species, there being not allowable generic or linking claim. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicants respectfully submit that in the Office Action mailed on November 26, 2002, Paragraph No. 1 on page 2 acknowledged "Applicant's election **with traverse** of Invention I and species 1 (claims 39-43, and 48-51) in Paper No. 7." (Emphasis added). On page 3 of the Office Action mailed on November 26, 2002, the restriction and election of species requirements were deemed proper and therefore made **final**. Thus, it is not understood why the present Office Action is now alleging that Applicants' Provisional Election filed on September 27, 2002 did not "distinctly and specifically point out the

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supposed errors in the restriction requirement” so that the election has been treated as an election without traverse. Applicants respectfully submit that the Provisional Election filed on September 27, 2002 did distinctly and specifically point out the supposed errors in the restriction requirement, for instance, as alluded to in the Office Action mailed on November 26, 2002, “[t]he traversal is on the ground(s) that whether or not the inventions of Groups I, II, III, and IV have a different mode of operation is immaterial and has not [sic] thing to do with the special technical feature of the claims referred to in PCT Rules 13.2.” Other errors with respect to both the Restriction Requirement and the Election of Species Requirement were pointed out in the six (6) pages of the Provisional Election. Based on the foregoing, Applicants respectfully submit that Applicants complied with the requirement to “distinctly and specifically point out the supposed errors in the restriction requirement,” and therefore, the Manual of Patent Examining Procedure (hereinafter “MPEP”) § 818.03(a) is not applicable so that the Provisional Election should not be treated as an election without traverse, but instead as an election with traverse as was done in the Office Action mailed on November 26, 2002.

In the Amendment filed on February 20, 2003, Applicants respectfully requested that the examiner consider the Information Disclosure Statement filed on August 9, 2001. More particularly, in Paragraph No. 3 on page 3, the Office Action mailed on November 26, 2002 alleged that the Information Disclosure Statement filed on August 9, 2002 failed to comply with 37 C.F.R. § 1.98(a)(3) because it did not include “a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. § 1.56 most

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knowledgeable about the content of the information, of each patent listed that is not in the English language.”

Applicants respectfully submit that the last three listed references (i.e., references listed as AT through AV on the List of References Cited by Application (i.e., PTO-Form 1449) did indeed have a statement of relevance since all three references were discussed in the Background Art section of the specification (i.e., the AT reference or Japanese Patent Application Publication No. 9-262262 being discussed on pages 1 and 10 of the specification, the AU reference or Japanese Patent Application Publication No. 6-190012 being discussed on pages 3, 8, and 12 of the specification, and the AV reference or Japanese Patent Application Publication No. 2511451 being discussed on page 8 of the specification) and also had a English abstract attached thereto, either the discussion of the reference in the specification or the English abstract serving as the statement of relevance.

Further, the references AK through AS of the Information Disclosure Statement filed on August 9, 2001 were all references listed on an International Search Report and a copy of the International Search Report in English was filed with the Information Disclosure Statement filed on August 9, 2001. MPEP § 1893.03(g), entitled Information Disclosure Statement in a National Stage Application, states, as follows:

An extensive discussion of Information Disclosure Statement practice is to be found in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of a national stage application in the same manner as for a domestic national application. The declaration requires the same averments with respect to the duty under 37 CFR 1.56.

When an international application is filed under the Patent Cooperation Treaty (PCT), prior art documents may be cited by the examiner

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in the international search report and/or the international preliminary examination report. When a national stage application is filed under 35 U.S.C. 371, or a national application is filed under 35 U.S.C. 111 claiming benefit of the filing date of the international application, it is often desirable to have the examiner consider the documents cited in the international application when examining the national application.

As a result of an agreement among the European Patent Office (EPO), Japanese Patent Office (JPO), and the United States Patent and Trademark Office (USPTO), copies of documents cited in the international search report issued by any one of these International Searching Authority Offices generally are being sent to the other Offices when designated in the international application. Accordingly, in many national stage applications where the international search was conducted by the EPO, JPO, or USPTO, copies of the documents cited in the international search report are made available to the examiner in the national stage application.

When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner WILL consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date. (Emphasis added).

Applicants respectfully submit that they are enclosing a copy of the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 C.F.R. 1.494 and 1.495 (hereinafter

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"FORM PCT/DO/EO/903") which was mailed from the U.S. Patent and Trademark Office on June 15, 2001. The FORM PCT/DO/EO/903 indicates in Paragraph No. 4 (the fifteenth box down) that a copy of the International Search Report and copies of the references cited therein were received by the U.S. Patent and Trademark Office. Thus, according to MPEP § 1893.03(g), "the Examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file.

Applicants respectfully submit that they have not failed to comply with 37 C.F.R. § 1.98(a)(3), but rather because references AK-AS listed on the Information Disclosure Statement filed on August 9, 2001 are from the International Search Report and because the present application was filed under 37 C.F.R. § 371, even though references AK-AS are foreign references, Applicants are not required to give a statement of relevance and the examiner must consider references AK-AS listed on the Information Disclosure Statement filed on August 9, 2001.

Based on the foregoing, as a convenience for the examiner, Applicants have enclosed a copy of the Information Disclosure Statement and List of References Cited by Applicant (i.e., PTO-Form 1449) along with the date-stamped filing receipt, and Applicants respectfully request that the examiner consider the Information Disclosure Statement filed on August 9, 2001 and in the next communication from the USPTO include copy of the List of Reference Cited by Applicant (i.e., PTO-Form 1449) which has each reference initialed, and which has been signed and dated.

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Figs. 11 and 52 have been amended to correct minor informalities therein. More particularly, Fig. 11 has been amended to change "04" to --04-- for consistency with the specification, and Fig. 52 has been amended to correct a typographical informality to change "LUMBER" to --LUMBAR--. Applicants respectfully submit that the amendments to the drawing figures do not add new matter. Based on the foregoing, Applicants respectfully request approval of the replacement sheets.

The specification has been amended to correct minor typographical, grammatical, and/or idiomatic informalities in the specification. Applicants respectfully submit that the amendments to the specification do not add new matter.

Claims 39-42, 49, and 50 have been amended. More particularly, independent claim 39 has been amended to recite a sensor configured to detect a position of a specific portion of the body of the user with respect to the massaging apparatus by determining a relationship between a vertical position of the supporting arm and a pivotal position of the supporting arm. Independent claim 40 has been amended to recite a pivotal-position-detecting sensor configured to detect that the supporting arm has reached a prescribed range of pivotal positions. Independent claim 41 has been amended to recite pivotal-position-detecting sensor means for detecting a prescribed range of pivotal positions of the supporting arm. Independent claim 42 has been amended a sensor configured to detect a position of a specific portion of the body of the user with respect to the massaging apparatus by determining a vertical position of the supporting arm at a moment when a pivotal position of the supporting arm has reached a prescribed range.

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Applicants respectfully submit that the amendments to claims 39 and 42 now recite a sensor which is structurally configured to perform the recited function of detecting a position of a specific portion of a body of the user (i.e., shoulder) either by determining a relationship between a vertical position of the supporting arm and a pivotal position of the supporting arm or by determining a vertical position of the supporting arm at a moment when a pivotal position of the supporting arm has reached a prescribed range. Thus, Applicants respectfully submit that the 35 U.S.C. § 112, second paragraph, rejection has now been overcome.

Further, with respect to either the 35 U.S.C. § 102(a) rejection of the claims based upon *WO '611* alone or the 35 U.S.C. § 103(a) rejection of the claims based upon *WO '611* in view of *Imazaike et al.*, Applicants respectfully submit that neither *WO '611* alone nor *WO '611* in combination with *Imazaike et al.* teach or suggest, as is recited in independent claims 39 or 42, a sensor configured to detect a position of a specific portion of the body of the user with respect to the massaging apparatus by determining either a relationship between a vertical position of the supporting arm and a pivotal position of the supporting arm or a vertical position of the supporting arm at a moment when a pivotal position of the supporting arm has reached a prescribed range. Additionally, neither *WO '611* alone nor *WO '611* in combination with *Imazaike et al.* teach or suggest, as is recited in independent claims 40 and 41, a pivotal-position-detecting sensor configured to detect that the supporting arm has reached a prescribed range of pivotal positions or pivotal-position-detecting sensor means for detecting a prescribed range of pivotal positions of the supporting arm.

Briefly recapitulating, the operation of the massaging apparatus of the present invention may be explained in reference to Fig. 8 as follows. A user sits down in the chair-

type massaging apparatus 1 of the present invention so that his lower back is pressed against the first and second therapeutic members 8 and 9 of the massaging unit 7 which is located in its lower vertical position adjacent the lower limit switch S2. As shown in Fig. 1, the supporting arm 26 is normally held in the lower pivotal position a (as shown by the solid lines) by the tension spring 55. However, when the user sits in the chair-type massaging apparatus 1 so that his back is pressed against the first and second therapeutic members 8 and 9, which are rotatably mounted on the supporting arm 26, the force of the user's body urge the supporting arm 26 into its higher pivotal position b as shown by the dashed line in Fig. 1. In this higher pivotal position b, the supporting arm 26 is pivoted in relation to the driving arm 25, on which it is pivotally supported, so that it no longer blocks light from the light emitting element 57 to be received by the light receiving element 58 (see Fig. 2). As the entire massaging unit 7 moves vertically upwardly toward upper limit switch S1, the supporting arm 26 remains in the higher pivotal position b until the first therapeutic member 8 reaches the user's shoulder at which time the supporting arm 26 pivots to the lower pivotal position a and the pivotal-position-detecting sensor 60 detects the a position of a specific portion of the body of the user (i.e., user's shoulder) with respect to the massaging apparatus by determining a relationship between a vertical position of the supporting arm (i.e., near upper limit switch S1) and a pivotal position (i.e., lower pivotal position a) of the supporting arm 26. The sensor 60 detects that the prescribed range of pivotal positions of the supporting arm 26 has been reached because the supporting arm has pivoted to its lower pivotal position a so that light from the light emitting element 57 is blocked from being receiving by the light receiving element 58.

WO '611 discloses a massaging device for a rest armchair 7, wherein the massaging device includes therapeutic members 6 and 15 rotatably supported on a supporting arm pivotally connected to a drive arm and wherein the massaging device is movable up and down on a spindle 8 in the chair 7. As shown in Fig. 1 of *WO '611*, each of left and right eccentric and inclined shafts 2 and 11 and left and right eccentric shafts 4 and 13 are associated with a magnetic sensor 17. Each magnetic sensor 17 of *WO '611* merely serves to determine the position of one of the shafts 2, 4, 11, or 13. With such position of each one of the shafts 2, 4, 11, or 13 being determined by its associated magnetic sensor 17, the electronic control unit 18 of *WO '611* can control the activation of the left and right kneading motor 1 and 10 and the left and right clapping motors 3 and 12, based upon the position of each shaft 2, 4, 11, or 13, according to a specific order or instruction received from the user. In other words, the position of each shaft 2, 4, 11, or 13 is determined via the sensor 17 to relay to the electronic control unit 18 so that the electronic control unit 18 may activate the motor accordingly to thus accomplish the commands of the user.

In contrast, the sensor of the present invention senses the position of the supporting arm to determine when the supporting arm reaches a certain angle of orientation, which angle changes upon arrival of the supporting arm at a specific position of the user's body (i.e., the shoulder).

The magnetic sensor 17 of *WO '611* cannot make such a determination. Indeed, the position of each of the shafts 2, 4, 11, and 13 of *WO '611* being determined separate from where the shaft is located in relation to the user's body. The position of each of the shafts 2, 4, 11, and 13 of *WO '611* is dictated by the electronic control unit 18 in response to

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commands from the user. The position of each of the shafts 2, 4, 11, and 13 of *WO '611* is not dictated by where the shaft or massaging unit is located in relation to the body of the user.

Further, even if the position sensor 144 of *Imazaike et al.* were substituted for the magnetic sensors of *WO '611*, the resulting massaging apparatus would not be capable of performing the function of detecting a position of a specific portion of the body of the user (i.e., shoulder) with respect to the massaging apparatus either by determining a relationship between a vertical position of the supporting arm and a pivotal position of the supporting arm or by determining a vertical position of the supporting arm at a moment when a pivotal position of the supporting arm has reached a prescribed range. Furthermore, the result of combining the massaging apparatus of *WO '611* with the position detector of *Imazaike et al.* would not result in a pivotal-position-detecting sensor configured to detect that the supporting arm has reached a prescribed range of pivotal positions or pivotal-position-detecting sensor means for detecting a prescribed range of pivotal positions of the supporting arm.

Applicants respectfully submit that the amendments to claims 39-42 do not add new matter. Applicants respectfully submit that claim 48, claims 43 and 50, claim 51, and claim 49 are directly dependent on amended claim 39, amended claim 40, amended claim 41, and amended claim 42, respectively, so that arguments serving to patentably distinguish amended claim 39, amended claim 40, amended claim 41, and amended claim 42 from the prior art of record are available, among others, to patentably distinguish claim 48, claims 43 and 50, claim 51, and claim 49, respectively. Based on the foregoing, Applicants respectfully request

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withdrawal of the rejections of the claims under 35 U.S.C. § 112, second paragraph, 35

U.S.C. § 102(a), and 35 U.S.C. § 103(a), and allowance of claims 39-43 and 48-51.

In view of the foregoing, claims 39-43 and 48-51 are believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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